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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,361	12/01/2000	Robert Bible, JR.	11298.4	4116

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,361

Applicant(s)

BIBLE, ET AL.

Examiner

Jalatee Worjloh

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed on August 4, 2003, in which claims 1, 11 and 17 were amended and claims 13 and 14 canceled.

Response to Arguments

2. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

1. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claim 11, the claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a

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concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Referring to claim 17, the claim is directed to an abstract idea that is not tied to any practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result. *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0112171 to Ginter et al. in view of US Patent No. 6226618 to Downs et al.

Referring to claims 1 and 9, Ginter et al. disclose decrypting a first part (i.e. “permission record”) of said file using a first key, ascertaining said second key (i.e. “decryption key”) from

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said first part of said file during said decrypting step, and employing said second key to decrypt a second part (i.e. "the content") of said file for use in revealing said second part; wherein said second part is a content to be controlled by the buyer (see paragraphs [1056]; [1058], lines 20-24; [1194]; and Figures 17 & 18). Ginter et al. do not expressly disclose the two-part file is selectively encrypted by a seller and a transaction agency for transfer of complete file control to a buyer, said decrypting step is accomplished by the transaction agency for the buyer or wherein the second part was encrypted by the seller for decryption by the buyer. Downs et al. disclose the two-part file is selectively encrypted by a seller (i.e. "service provider") and a transaction agency (i.e. "clearinghouse") for transfer of complete file control to a buyer and the second part was encrypted by the seller for decryption by the buyer (see col. 7, lines 16-22; col. 9, lines 38-50; col. 10, lines 61-65; col. 18 & 19 table, specifically, steps 125-127), and said decrypting step is accomplished by the transaction agency (i.e. "clearinghouse") for the buyer (see col. 19 table, steps 144-148). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Ginter et al. to include the two-part file is selectively encrypted by a seller and a transaction agency for transfer of complete file control to a buyer, said decrypting step is accomplished by the transaction agency for the buyer or wherein the second part was encrypted by the seller for decryption by the buyer. One of ordinary skill in the art would have been motivated to do this because it provides secure delivery of the electronic content (see Downs et al. col. 3, lines 40-42). Also, it provides an additionally level of security.

Referring to claim 2, Ginter et al. disclose presenting said file on the Internet, selecting said file from the Internet [1762], and sending said first part of said file to a transaction agent

(i.e. “clearinghouse”) (see paragraph [1087]). Ginter et al. do not expressly disclose the transaction agency performing the decrypting step and said ascertaining step (see paragraph [1087] and fig. 21). Downs et al. disclose the transaction agency (i.e. “clearinghouse”) performing the decrypting and ascertaining steps (see col. 19 table steps 144-148). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Ginter et al. to include the transaction agency for performing the decrypting and ascertaining steps. One of ordinary skill in the art would have been motivated to do this because it provides additional security and prevents unauthorized individuals from accessing the content.

Referring to claim 3, Ginter et al. disclose the first key is a public key and said second key is a private key (see paragraphs [1056], [1058] and [1194]). Note. Paragraph [1056] indicates that the permissions record (i.e. “first part”) stores decryption keys (i.e. “second key”) for accessing the encrypted content. The examiner presumes that these decryption keys may include a private key. Also, paragraph [1058] states that permissions record and key blocks can be encrypted with a private key. This system supports Public-Key encryption; thus, since the permissions record (i.e. “first part”) is encrypted with the private key it must be decrypted with the public key (see paragraphs [1533], [1534]). Ginter et al. do not expressly disclose the public key is provided by a transaction agent. Downs et al. disclose the public key is provided by a transaction agent (see col. 18 table step 125). Notice, “ The Content 113 and a subset of its metadata is encrypted with a Symmetric Key by the SC Packer. This tool then encrypts the key using the Public Key of the Clearinghouse(s) 105 to produce an Encrypted Symmetric Key.” At the time the invention was made, it would have been obvious to a person of ordinary skill in the

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art to modify the method disclose by Ginter et al. to include the step wherein the public key is provided by a transaction agent. One of ordinary skill in the art would have been motivated to do this because it provides secure delivery of the electronic content (see Downs et al. col. 3, lines 40-42).

Referring to claims 4, 5 and 15, Ginter et al. disclose the method wherein said employing step is accomplished by said transaction agent and a buyer (see paragraph [1087], and Fig. 21). Note. Administrative objects 870 comprises the permission record 808 (i.e. “first part”) and the content 812 (i.e. “second part”); these objects “are sent between two VDE nodes, for example, a VDE clearinghouse service, distributor, or client administrator and an end user’s electronic appliance”, which in turns decrypts the permissions records and then the encrypted content. Thus, any node (see fig. 1), including transaction agent or the buyer can perform the employing step.

Referring to claim 6, Ginter et al. disclose the method wherein said file periodically changed (see [2164]. Note. Ginter et al. disclose “periodical publication” which implies that the file is periodically changed.

Referring to claim 7, Ginter et al. disclose the method wherein said first part is an overhead including said second key and having commercial material about said file, said commercial material including pricing and payment terms (see paragraph [1903]).

Referring to claim 8, Ginter et al. disclose the method further comprising a header having advertising material about said second part and information material about a seller (see paragraph [2170]).

Referring to claim 10, Ginter et al. disclose the method wherein the content includes works elected forma group consisting of books, documents, pamphlets, movies, songs, games, pictures and software (see paragraph [1085], lines 1-10).

Referring to claim 11, Ginter et al. disclose presenting a file, said file being created by the seller and containing at least an overhead and a content, said overhead being encrypted with a first key and at least a portion of said content being encrypted with a second key by the seller, decrypting said overhead of said file by employing said first key to ascertain said second key, and decrypting said content of said file by employing said second key to reveal said file to accomplish the transfer of file control to said buyer (see figs. 1, 17, 18; paragraphs [0378], [0137], [1056]; [1058], lines 20-24; [1087], and [1194]). Ginter et al. do not expressly disclose said overhead being encrypted with a first key by the transaction agency, wherein said decrypting is accomplished by the transaction agency for the buyer. Downs et al. disclose said overhead being encrypted with a first key by the transaction agency, i.e. "clearinghouse" (see col. 18 table step 125), wherein said decrypting is accomplished by the transaction agency for the buyer (see col. 9 table, steps 144-148). Notice, " The Content 113 and a subset of its metadata is encrypted with a Symmetric Key by the SC Packer. This tool then encrypts the key using the Public Key of the Clearinghouse(s) 105 to produce an Encrypted Symmetric Key." At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Ginter et al. to include the step overhead being encrypted with a first key by the transaction agency, and wherein said decrypting is accomplished by the transaction agency for the buyer. One of ordinary skill in the art would have been motivated to

do this because it provides secure delivery of the electronic content (see Downs et al. col. 3, lines 40-42).

Referring to claims 12, Ginter et al. disclose the method wherein the presenting step is accomplished on an Internet (see paragraph [1762]), and further wherein said first key is a public key said second key is a private key (see paragraph [1058], lines 20-24). Note. Paragraph [1056] indicates that the permissions record (i.e. "first part") stores decryption keys (i.e. "second key") for accessing the encrypted content. The examiner presumes that these decryption keys may include a private key. Also, paragraph [1058] states that permissions record and key blocks can be encrypted with a private key. This system supports Public-Key encryption; thus, since the permissions record (i.e. "first part") is encrypted with the private key it must be decrypted with the public key (see paragraphs [1533], [1534]).

Referring to claims 16 and 19, Ginter et al. disclose the method wherein said overhead includes said second key and commercial material about said file, said commercial material including pricing and payment terms, and further wherein said content includes work selected from a group consisting of books, documents, pamphlets, movies, songs, games, pictures and software (see paragraphs [1903]; [2170]; [1085], lines 1-10).

Referring to claims 17 and 18, Ginter et al. disclose a transaction agent, a public key, a private key, a seller for creating said file and publishing said file on the Internet, said file having at least a first part and a second part with said first part being encrypted using said public key and said second part being encrypted with said private key; and a buyer for selecting said file from the Internet and sending said first part of said file to said transaction agent for decryption

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thereof by said transaction agent using said public key to ascertain said private key for subsequent use in decrypting said revealing said second part of said file for use by said buyer to transfer complete file control to said buyer; wherein said private key is provided by said seller (see figs. 1, 17, 18; paragraphs [0378], [0137], [1056]; [1058], lines 20-24; [1087], and [1194], [1762]). Note. The seller gives request content which comprises the permissions record (includes the key) is given to the buyer; thus, the seller provides the private key. Ginter et al. do not expressly disclose said first part being encrypted by the transaction agency. Downs et al. disclose the encrypted by the transaction agency (see col. 18 table step 125). Notice, “ The Content 113 and a subset of its metadata is encrypted with a Symmetric Key by the SC Packer. This tool then encrypts the key using the Public Key of the Clearinghouse(s) 105 to produce an Encrypted Symmetric Key.” At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Ginter et al. to include the said first part being encrypted by the transaction agency. One of ordinary skill in the art would have been motivated to do this because it provides secure delivery of the electronic content (see Downs et al. col. 3, lines 40-42).

Referring to claim 20, Ginter et al. disclose a buyer's account maintained by said transaction agent for said buyer, a seller's account maintained by said transaction agent for said seller, and means for transferring funds of said value from said buyer's account to said seller's account when said second part of said file is revealed (see paragraphs [0217], [0183]).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 5978476 to Redman et al. discloses access restriction to circuit designs
- International Publication No. WO 00/14918 to Garrison discloses a system and method for encrypting data messages

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306, 703-746-9443 for Non-Official/Draft .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

October 9, 2003


JAMES P. TRAMMELL
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